HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. ___10017722-1___

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s):   Chris Mesa et al.

Confirmation No.: 1784

Application No.: 09/944,659

Examiner: Truc T. Chuong

Filing Date: Aug. 31, 2001

Group Art Unit: 2179

Title: Scanning To At Least One Of Multiple Destinations

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

RECEIVED
OIPE/JCWS
APR 29 2005

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on **Feb. 28, 2005** .

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) $500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

( ) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

     ( ) one month $120.00
     ( ) two months $450.00
     ( ) three months $1020.00
     ( ) four months $1590.00

    ( ) The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of ___$500.00___ . At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

( ) I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Alexandria, VA 22313-1450. Date of Deposit:_____
              OR
(X) I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (703) 872-9306 on Apr. 28, 2005.
Number of papers: 11

Respectfully submitted,
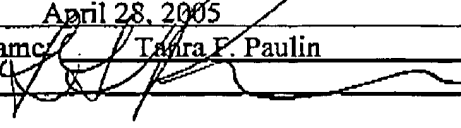
Chris Mesa et al.

By _____

Steven R. Ormiston

Attorney/Agent for Applicant(s)

I hereby certify that this correspondence is being facsimile transmitted to the U.S. Patent and
Trademark Office on the date shown below.
Date of Deposit: _____ April 28, 2005 _____
Typed or printed name: _____ Tamra P. Paulin _____
Signature: _____

RECEIVED
CENTRAL FAX CENTER
APR 2 8 2005

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Chris Mesa et al.

SERIAL NO.: 09/944,659   **GROUP ART UNIT:** 2174

FILED: August 31, 2001   **EXAMINER:** T. Chuong

TITLE: Scanning To At Least One Of Multiple Destinations

APPELLANTS'/APPLICANTS' OPENING BRIEF ON APPEAL

1.   REAL PARTY IN INTEREST.

The real party in interest is Hewlett-Packard Development Company, LP, a
limited partnership established under the laws of the State of Texas and having a
principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter
"HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of
Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA.
The general or managing partner of HPDC is HPQ Holding, LLC.

2.   RELATED APPEALS AND INTERFERENCES.

There are no other appeals or interferences known to Appellants, Appellants'
legal representative or the Assignee which will affect or be directly affected by or have
a bearing on the Board's decision in the pending appeal.

3.   STATUS OF CLAIMS.

Claims 23-31 are pending. All pending claims are appealed.

4.   STATUS OF AMENDMENTS.

All amendments have been entered. No amendments were filed after the final action.

5.   SUMMARY OF CLAIMED SUBJECT MATTER.

Claim 23 recites a scanning method that includes:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability (Fig. 1, display 114; Fig. 2, step 210; and Specification, page 9, lines 21-23 and page 11, lines 8-10);

the input peripheral notifying a selected destination device that the device has been selected to receive data (Fig. 2, step 214 and Specification, page 11, lines 12-13);

in response to the notifying, the selected destination device requesting that the input peripheral begin transmitting data to the selected destination device (Fig. 3, step 316 and Specification, page 12,lines 2-3); and

in response to the requesting, the input peripheral scanning a document and transmitting data representing the document to the selected destination device (Fig. 2, steps 216, 218 and 220 and Specification, page 11, lines 17-20).

Claim 27 recites a scanning method that includes:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability and from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral (Fig. 2, step 210 and Specification, page 10, lines 8-21 and page 11, lines 8-10);

the input peripheral notifying a selected destination device that the device and a resource on the device have been selected to receive data (Fig. 2, step 214 and Specification, page 11, lines 12-13);

in response to the notifying, the selected destination device acknowledging a notification from the input peripheral (Fig. 3, step 316 and Specification, page 12,lines 2-3); and

in response to an acknowledgement from the selected destination device, the input peripheral scanning a document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral (Fig. 2, steps 216, 218 and 220; Fig. 3, steps 318 and 320; and Specification, page 11, lines 17-20 and page 12, lines 4-5).

Claims 28 and 31 are computer medium counterparts to method Claims 23 and 27.

6.   GROUNDS FOR REJECTION TO BE REVIEWED.

A.   Blasio (2002/0085244) does not teach the input peripheral notifying one of multiple destination devices that the device has been selected to receive data.

B.   Blasio does not teach the selected destination device requesting that the input peripheral begin transmitting data to the destination device and, in response to the request, the input peripheral scanning a document and transmitting data representing the document to the destination device.

C.   Blasio does not teach a two tiered destination selection scheme as claimed.

7.   ARGUMENT.

A.   Ground For Rejection A (Claims 23-31) – Blasio Does Not Teach The Input Peripheral Notifying One Of Multiple Destination Devices That The Device Has Been Selected To Receive Data.

Claims 23-31 were rejected under Section 102 as being anticipated by Blasio (2002/0085244). The rejection is based on the assertion that Blasio teaches the input peripheral notifying one of multiple destination devices that the device has been selected to receive data. Applicants respectfully submit that this assertion is not correct.

Claims 23 and 27 recite displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral and the input peripheral notifying a selected one of the multiple destination devices that the device has been selected to receive data. Claims 28 and 31, as computer medium counterparts to Claims 23 and 27, contain similar limitations.

In Blasio, by contrast, the input peripheral communicates with only a single host device (host computer 200). The host device, not the input peripheral, communicates with one of multiple final destination devices. Blasio, Fig. 1 and paragraphs 0041, 0042 and 0045. In Blasio, a user selects the final destination for a scan from a list of multiple final destinations. Blasio, paragraph 0041. The selection is sent to host computer 200. Host computer 200 pulls the scan data from the input peripheral and sends the data on to the final destination selected at the input peripheral. Blasio, paragraphs 0042 and 0045. To the extent host computer 200 in Blasio might somehow be deemed a selected destination device, it is not selected from a display of multiple destination devices. That is to say, the input peripheral in Blasio does not notify a selected one of multiple destination devices as required in Claims 23 and 27. In fact, it does not even appear that host computer 200 in Blasio notifies the selected one of multiple final destination devices that it has been selected to receive data – apparently host computer 200 just sends the data unannounced to the selected device.

B.   Ground For Rejection B (Claims 23-31) – Blasio Does Not Teach The Selected Destination Device Requesting That The Input Peripheral Begin Transmitting Data To The Destination Device And, In Response To The Request, The Input Peripheral Scanning A Document And Transmitting Data Representing The Document To The Destination Device.

The rejection of Claims 23-31 is also based on the assertion that Blasio teaches the selected destination device requesting that the input peripheral begin transmitting data to the destination device and, in response to the request, the input peripheral scanning a document and transmitting data to the destination device. Applicants respectfully submit that this assertion is not correct.

Claims 23 and 27 recite the input peripheral notifying a selected destination device that the device has been selected to receive data. In response to this notification, the selected destination device requests that the input peripheral begin transmitting data to the selected destination device. Then, in response to this request, the input peripheral scans a document and transmits data representing the document to the selected destination device. Claims 28 and 31, as computer medium counterparts to Claims 23 and 27, contain similar limitations.

In Blasio, host computer 200 pulls the scan data from the input peripheral and sends the data on to the final destination selected at the input peripheral. Blasio, paragraphs 0042 and 0045. There is nothing in Blasio that can reasonably be interpreted as teaching the sequence of communications between the selected destination device and the input peripheral recited in Claims 23 and 27 — in response to notification from input peripheral, destination device requests input peripheral begin transmitting and then, in response to this request, the input peripheral scan the document and transmits data to the selected destination device. Even it is assumed that similar communications somehow take place in Blasio (which they do not), host computer 200 handles any such communications with the selected destination device, not the input peripheral as required by Claims 23 and 27. Blasio, Fig. 1 and paragraphs 0041, 0042 and 0045.

C.   Ground For Rejection C (Claims 25-27 and 30-31) — Blasio Does Not Teach A Two Tiered Destination Selection Scheme As Claimed.

Claims 25 and 27 recite a two tiered destination selection scheme — (1) displaying a user interface from which one or more of multiple destination devices and a resource on one or more of the devices may be selected to receive data from an input peripheral and (2) the input peripheral transmitting data representing the document to a resource on the selected destination device. Claims 30 and 31, as computer medium counterparts to Claims 25 and 27, contain similar limitations.

Although Blasio allows a user to map a name displayed on the input peripheral to a resource on a destination device, folder 300 for example, it does not provide a display from which the user can select both one of multiple devices and a resource on the selected device. Blasio, paragraphs 0054. Also, as noted above, the input peripheral in Blasio does not transmit the scanned document data to the destination device or a resource on the destination device. Blasio, therefore, does not teach these additional limitations in Claims 25 and 27 and 30-31.
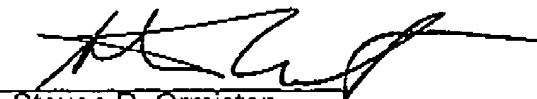
Finally, Applicants note, respectfully but with much frustration, that more and more Examiners seem to have gotten in the habit of supporting a rejection by the simple expedient of quoting each of the limitations in a claim and then citing to passages in the reference, without making any attempt at all to explain how the cited passages might reasonably be deemed to meet the claim limitations. The Applicant is

then left to speculate on a reasonable basis for the rejection, or to confront the Examiner with his or her failure to make out a prima facie case and risk a final action with no real opportunity to address the substance of the rejection. And so it is in this case. The Examiner did not offer any explanation supporting his rejection until the Advisory Action was issued. And, so far as Applicant can tell, the brief explanation appended to the Advisory Action does not address the claim limitations noted above in Sections A, B and C of this Argument.

Perhaps in his Answer to this Opening Brief, the Examiner will explain in specific detail which elements and which process steps in Blasio can reasonably be deemed to teach each of the limitations in each of the claims, and thereby afford the Applicants a fair opportunity to respond to the substance of the rejection. If not, then the claims should be allowed outright on the grounds that the Examiner still has not established a prima facie case of anticipation.

Respectfully submitted,
Christopher Mesa

By _____
Steven R. Ormiston
Reg. No. 35,974
(208) 433-1991 x204

APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

23.   A scanning method, comprising:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability;

the input peripheral notifying a selected destination device that the device has been selected to receive data;

in response to the notifying, the selected destination device requesting that the input peripheral begin transmitting data to the selected destination device; and

in response to the requesting, the input peripheral scanning a document and transmitting data representing the document to the selected destination device.

24.   The method of Claim 23, wherein the input peripheral comprises a scanner or a multifunction peripheral.

25.   The method of Claim 23, further comprising displaying a user interface from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral and wherein the input peripheral scanning a document and transmitting data representing the document to the selected destination device comprises the input peripheral scanning the document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral.

26.   The method of Claim 25, wherein the resource comprises an application program, a telephone number for a facsimile transmission of the data, an email address to send the data, or a storage location to store the data.

27.   A scanning method, comprising:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability and from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral;

the input peripheral notifying a selected destination device that the device and a resource on the device have been selected to receive data;

in response to the notifying, the selected destination device acknowledging a notification from the input peripheral; and

in response to an acknowledgement from the selected destination device, the input peripheral scanning a document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral.

28.   A computer readable medium having computer executable instructions thereon for:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability;

the input peripheral notifying a selected destination device that the device has been selected to receive data;

in response to the notifying, the selected destination device requesting that the input peripheral begin transmitting data to the selected destination device;

in response to the requesting, the input peripheral scanning a document and transmitting data representing the document to the selected destination device.

29.   The medium of Claim 28, wherein the input peripheral comprises a scanner or a multifunction peripheral.

30.   The medium of Claim 28, further comprising instructions for displaying a user interface from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral and wherein the instructions for the input peripheral scanning a document and transmitting data representing the document to the selected destination device comprise instructions for the input peripheral scanning the document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral.

31.   A computer readable medium having computer executable instructions thereon for:

displaying a user interface from which one or more of multiple destination devices may be selected to receive data from an input peripheral having a scanning capability and from which a resource on one or more of the multiple destination devices may be selected to receive data from the input peripheral;

the input peripheral notifying a selected destination device that the device and a resource on the device have been selected to receive data;

In response to the notifying, the selected destination device acknowledging a notification from the input peripheral; and

in response to an acknowledgement from the selected destination device, the input peripheral scanning a document and transmitting data representing the document to a resource on the selected destination device selected to receive data from the input peripheral.